

**REMARKS**

Claims 1-15 have been examined. Claims 9-15 have been canceled without prejudice or disclaimer. New claims 16-23 are hereby added by this Amendment.

The Examiner has acknowledged the claim for foreign priority, but has failed to indicate acceptance of the formal drawings (1-5b). Applicants request that the Examiner indicate acceptance of the formal drawings.

**Claim Objections**

The Examiner objected to claims 1-8 for containing the limitation “a packaging case” or “and a packaging case.” Applicants submit the present amendments to the claim obviate these objections.

**Claim Rejections - 35 U.S.C. § 102**

The Examiner rejected claim 1 under § 102(b) as being unpatentable over Goeb et al. (US 5,688,573). Applicants traverse this rejection for the reasons set forth below.

Applicants respectfully submit Goeb fails to disclose, at least, “irradiating a laser beam on a front face of a packaging case produced by a paper sheet having a colored layer constituted by a coloring agent and a resin film layer for protecting the front face on the front face,” as recited in claim 1.

In particular, the Examiner contends the top layer corresponds to the resin film layer for protecting the front face. (*Office Action*, p. 3). However, in contrast to the Examiner’s contention, Applicants submit the top layer 10 corresponds to a coloring layer. Specifically, it is a portion of top layer 10 that is removed to create the letters in Goeb. Consequently, because this portion of top layer 10 is removed to create the letter, it is not a protective layer, but to the contrary, it is a coloring layer. (*See* FIGS. 7 -10; col. 8, lines 1-37).

Therefore, Applicants submit Goeb fails to disclose any resin film layer for protecting the front face on the front face as recited in claim 1.

Thus, Applicants submit claim 1 is allowable over Goeb for at least this reason.

**Claim Rejections - 35 U.S.C. § 103**

The Examiner rejected claims 1, 5, 6 and 8 under § 103(a) as being unpatentable over Hughes (US 6,169,266) in view of Ward et al. (US 2,192,423).

Hughes relates to a method of etching multilayer coated surfaces using a laser to add graphics and text to a coated article. Hughes discloses coating an article with at least two layers, an overcoat layer 26 and an undercoat layer 24. (col. 8, lines 12-15). These layers are of different colors to provide a contrast in order to facilitate reading of the graphics and text etched into the layers. (col. 8, lines 40-43).

Ward et al. relates to a standard paper bag for packaging a product that is covered by strips of material C-C' to conceal the identity of the package. (p. 2, lines 37-60, right column) (*see* FIG. 6). These strips of material C-C' may be made of paper.

In the rejection, the Examiner contends that Hughes teaches a method of forming a display which could inherently be used as a display of a packaging case, but concedes that Hughes is silent with regard to a paper sheet. To compensate for this deficiency of Hughes, the Examiner applies Ward to teaching a paper sheet, and contends it would have been *prima facie* obvious to one of ordinary skill to incorporate the method of Ward into that of Hughes because:

- a) Ward suggests ornamentation, which Hughes provides;
- b) Hughes suggests the method for any article where a design or indicia is required, which Ward provides;

c) the paper substrate of Ward would provide a strong and durable support layer to the invention of Hughes.

In contrast, Applicants submit the Examiner's reasons for combining the references fail to take into account the explicit teachings of the references, and likewise, fail to provide adequate reasons for combining the references in view of the technical disclosure of either reference. Therefore, the Examiner has failed to establish *prima facie* obviousness.

First, one of ordinary skill in the art would not find the Examiner's reasons persuasive as they are based on non-technical features of the applied references. Specifically, one of ordinary skill in the art would not rely on the Examiner's finding, i.e., that Ward suggests ornamentation, as a reason to combine the technical features of Hughes to the paper of Ward. The teaching of ornamentation is wholly insufficient as a reason for combining the multilayered coating with a paper surface.

Second, the Examiner contends that Hughes suggests the method for any article. This conclusory statement fails because the Examiner has failed to consider the reference as a whole. Notably, Hughes explicitly teaches using its multilayer coating technique as an alternative to labels or inked markings because they are susceptible to damage and wear. (col. 1, lines 34-40) Thus, Hughes *teaches away* from using paper labels. In contrast, Hughes discloses that by applying its method, graphics and text may be applied directly to the surface of the article in a manner that is substantially permanent and wear resistant. (col. 2, lines 30-34). Consequently, as taught by Hughes, the multilayer coating is a replacement for paper labeling, which is taught to be inferior for its wear properties.

Third, the Examiner's reasoning that Ward would provide a strong and durable support layer for the invention of Hughes is directly counter to Hughes' disclosure (Hughes teaches away

from this). Further, this statement is nowhere supported in Ward, which fails to contemplate multilayered etched coatings.

Additionally, Applicants submit it is impossible that any kind of exterior layer is necessarily usable.

Accordingly, Applicants submit the Examiner has failed to establish *prima facie* obviousness for failing to provide a valid reason to combine the references. Moreover, because no *prima facie* case of obviousness has been established, the suggested combination fails to teach or suggest, at least, “a paper sheet having a colored layer constituted by a coloring agent and a resin film layer for protecting the front face on the front face,” as recited in claim 1.

Thus, Applicants submit claim 1 is allowable over the applied combination for at least this reason. Further, Applicants submit claims 5, 6 and 8 are allowable at least by virtue of their dependency.

**Claim Rejections - 35 U.S.C. § 103**

The Examiner rejected claim 2 as being unpatentable over Hughes (US 6,169,266) in view of Ward (US 2,192,423), and in further view of Robertson (US 6,007,929).

Applicants respectfully submit because Robertson fails to compensate for the above noted deficiencies of the Hughes/Ward combination, claim 2 is allowable over this art, at least because of its dependency.

**Claim Rejections - 35 U.S.C. § 103**

The Examiner rejected claims 3 and 7 under § 103(a) as being unpatentable over Hughes in view of Ward, and in further view of Sonobe.

Applicants submit because Sonobe fails to compensate for the above noted deficiencies of the Hughes/Ward combination, claim 3 and 7 are allowable over this art, at least because of their dependency.

Additionally, Applicants also submit the Examiner has again failed to establish *prima facie* obviousness for the additional reason set forth below.

In the rejection, the Examiner contends that Hughes and Ward teach most of the features recited in claims 3 and 7, but concedes that Hughes and Ward are silent with regard to the UV coating material. To compensate for this deficiency, the Examiner applies Sonobe alleging it teaches a UV coating material (ultraviolet curing ink, *citing* col. 5, lines 16-17). As a reason to combine, the Examiner alleges that it would have been obvious to incorporate the method of Sonobe into that of Hughes because Hughes suggests wear resistant inks and the thermosetting inks of Sonobe would provide favorable wear resistance.

In response, Applicants submit the reasons to combine forwarded by the Examiner run counter to the disclosure of the applied references, and thus, appear to be an unsupportable *post hoc* attempt by the Examiner to support combining the prior art to meet the features recited in claims 3 and 7. That is, the Examiner is relying on impermissible hindsight.

First, the Examiner contends that Sonobe teaches a UV coating material. This is incorrect. Sonobe merely teaches of using an UV curable ink that is applied to paper using a flexographic press. (col. 2, lines 7-8; col. 5, lines 15-22). Furthermore, no portion of Sonobe teaches that this UV curable ink has favorable wear resistance. To this end, the only reference that mentions the wear properties of ink is Hughes. Notably, Hughes discloses that ink markings are susceptible to damage and wear, and presents the multilayered etched coatings disclosed therein as a solution to using inks. (col. 1, lines 37-41).

Accordingly, because no valid reason for combining the UV curable inks of Sonobe with the multilayer etched coatings of Hughes exists, and further, because the Examiner's rationale contradicts the express disclosure of the applied references, the Examiner has failed to establish *prima facie* obviousness. Consequently, the suggested combination of references fail to teach or suggest, at least, wherein the colored layer is formed by a UV coating material, as recited in claims 3 and 7.

Thus, Applicants submit claims 3 and 7 are allowable for the reasons set forth above.

**Claim Rejections - 35 U.S.C. § 103**

The Examiner rejected claim 4 under § 103(a) as being unpatentable over Hughes, in view of Ward and Robertson, and in further view of Sonobe.

Applicants submit the Examiner has failed to establish *prima facie* obviousness. In particular, the reason to combine Sonobe is deficient as outlined above with regard to claims 3 and 7. Accordingly, no *prima facie* case of obviousness has been established.

Thus, Applicants submit that claim 4 is allowable for at least this reason.

**New Claims**


New claims 16-23 are hereby added by this Amendment and submitted to be allowable, at least for the same reasons set forth above with regard to claim 1.

**Conclusion**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

  
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